UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,209	09/09/2003	Toshiyuki Noguchi	00862.023227.	9145

5514   7590   01/09/2008
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
PATEL, MANGLESH M

ART UNIT	PAPER NUMBER
2178	

MAIL DATE	DELIVERY MODE
01/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/657,209	NOGUCHI, TOSHIYUKI
	Examiner	Art Unit	
	Manglesh M. Patel	2178	.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 October 2007</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>16,18 and 20-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>2,16,18 and 20-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

1.   This **Non-Final** action is responsive to the RCE filed on 10/15/2007.

2.   Claims 1-15, 17 and 19 are canceled. Claims 16 and 18 & 20-22 are pending. Claims 16, 20 and 21 are independent claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 16 and 18 & 20-22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta (U.S. 6, 980, 319, filed on Mar 2, 2001) in view of Lin (U.S. 6,757,070 filed on Aug 21, 2001).

Regarding Independent claims 16, 20 and 21, Ohta discloses a communication apparatus, that communicates with an information providing apparatus via a network and connects to printers, comprising: a storage unit constructed to store printer driver programs, each which is assigned to at least one of the printers; A reception unit constructed to receive a recommended printing condition list <u>related to printing of the downloaded image data</u> from said information providing apparatus; An acquisition unit constructed to acquire printable condition information from the printer driver programs stored in said storage unit; A list extraction unit constructed to extract a printing condition selection list from the recommended printing condition list received by said reception unit, on the basis of the printable condition information acquired by said acquisition unit; A condition selection unit constructed to select a printing condition from the printing condition selection list extracted by said list extraction unit; A generation unit constructed to generate print data on the basis of the printing condition selected by said condition selection unit by using the printer driver program (column 7, lines 25-40, wherein the keyboard and mouse are used to select data for printing); Although Ohta describes a portable digital device connecting to a network that includes accessing various print stations by letting the user select one of the stations, which is part of the condition list he fails to explicitly teach all the features of a condition list associated with a printer type (column 2, lines 17-67). Lin teaches a reception means for receiving a printing condition list from another apparatus connected through a network (fig 7 & column 2, lines 30-61). Lin teaches a universal print driver that

includes receiving a condition list which includes the features of the printer. Instead of installing multiple drivers the universal driver allows a user to access all the properties of multiple printers located on a network, those properties are the condition list as shown in figure 7. Lin discloses wherein the printing condition selection list includes at least one of information about a printer model, information about a paper size for printing, information about a paper type for printing, and information about a layout for printing, thus these are conditions that are permitted to be used in order to allow printing of the downloaded image data (fig 7 & column 2, lines 30-61, wherein the condition selection list includes printer model, paper size, paper type etc..). Further fig 7 & column 2, lines 30-61 teaches wherein the browser allows the user to select a specific printer, therefore it includes a printer list and its printing properties such as paper size, paper source etc.. Furthermore each printer in the network would include a universal driver to be able to access printer properties. Ohta teaches a device connecting to a network to access a group of printers. Lin also teaches a device accessing a group of printers further allowing the device to have all the features of a particular printer by having a universal driver; these features make up the printing condition list. Both Lin and Ohta are analogous art because they are from the same field of endeavor of network printing. At the time of the invention it would have been obvious to one of ordinary skill in the art to include a printing condition list prior to printing. The motivation for doing so would have been to allow the user to have access to all the features of a particular printer thereby improving the print quality of the information. Therefore it would have been obvious to combine the teachings of Lin and Ohta for improving the quality of printed documents by allowing the user to have full access to the printer features by implementing a universal driver.

Regarding Dependent claim 18, with dependency of claim 16, Although Ohta describes accessing multiple printers which inherently includes the name of the printer before the user selects the printer he fails to explicitly teach other print list conditions such as paper size...etc. (note: only one of the conditions below has to be met, although Ohta does teach one Lin better discloses many of the printer conditions). Lin discloses wherein the printing condition selection list includes at least one of information about a printer model, information about a paper size for printing, information about a paper type for printing, and information about a layout for printing (fig 7 & column 2, lines 30-61, wherein the condition selection list includes printer model, paper size, paper type etc..). Ohta teaches a device connecting to a network to access a group of printers. Lin also teaches a device accessing a group of printers further allowing the device to have all the features of a particular printer by having a universal driver; these features make up the printing condition list. Both Lin and Ohta are analogous art because they are from the same field of endeavor of network printing. At the time of the invention it would have been obvious to one of ordinary skill in the art to include a printing

condition list prior to printing. The motivation for doing so would have been to allow the user to have access to all the features of a particular printer thereby improving the print quality of the information. Therefore it would have been obvious to combine the teachings of Lin and Ohta for improving the quality of printed documents by allowing the user to have full access to the printer features by implementing a universal driver.

Regarding Dependent claim 22, with dependency of claim 16, Although Ohta describes accessing multiple printers which inherently includes the name of the printer before the user selects the printer he fails to explicitly teach other print list conditions such as paper size…etc. (note: only one of the conditions below has to be met, although Ohta does teach one Lin better discloses many of the printer conditions). Lin discloses wherein the printing condition selection list includes at least one of information about a printer model, information about a paper size for printing, information about a paper type for printing, and information about a layout for printing, thus these are conditions that are permitted to be used in order to allow printing of the downloaded image data (fig 7 & column 2, lines 30-61, wherein the condition selection list includes printer model, paper size, paper type etc..). Ohta teaches a device connecting to a network to access a group of printers. Lin also teaches a device accessing a group of printers further allowing the device to have all the features of a particular printer by having a universal driver; these features make up the printing condition list. Both Lin and Ohta are analogous art because they are from the same field of endeavor of network printing. At the time of the invention it would have been obvious to one of ordinary skill in the art to include a printing condition list prior to printing. The motivation for doing so would have been to allow the user to have access to all the features of a particular printer thereby improving the print quality of the information. Therefore it would have been obvious to combine the teachings of Lin and Ohta for improving the quality of printed documents by allowing the user to have full access to the printer features by implementing a universal driver.

It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]

Response to Arguments

5.   Applicant's arguments filed 10/15/2007 have been fully considered but are not persuasive.

Applicant argues: In contrast, the characteristics of Ohta are provided by the printers, not the server. Additionally, the characteristics are specific to the printers themselves and bear no relation whatsoever to the print data. Thus, Ohta fails to teach features of the.claimed invention. (pg 8, paragraph 2)

However, much like Ohta, the printing conditions list of Lin is not seen to be related to printing of downloaded image data, but rather, is merely seen to be related to each printer. Thus, Lin is not seen to teach anything that, when combined with Ohta, would have resulted in the invention. (pg 9, paragraph 1)

However the examiner respectfully disagrees. The characteristics in Ohta are provided by a server see fig 2, numeral 13. The printing condition list of Both Ohta and Lin are "related to the printing of the downloaded image data" because it is this downloaded image data that the user wishes to print thereby sending a request (related by the request) and the server thus providing the user with a printing condition list.

It is **not necessary that the references actually suggest**, expressly or in so many words the changes or improvements that applicant has made. The test for combining references is what the references **as a whole would have suggested** to one of ordinary skill in the art. In re Sheckler, 168 USPQ 716 (CCPA 1971); In re McLaughlin 170 USPQ 209 (CCPA 1971); In re Young 159 USPQ 725 (CCPA 1968).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M,F 8:30-6:00 T,TH 8:30-3:00 Wed 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571)272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel
Patent Examiner
January 3, 2008

CESAR PAULA
PRIMARY EXAMINER